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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,848	08/31/2001	Toru Mineyama	09812.0167-00000	3624

22852 7590 11/30/2006

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EXAMINER

VU, NGOC K

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/944,848	MINEYAMA, TORU	
	Examiner	Art Unit	
	Ngoc K. Vu	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-40 is/are allowed.
- 6) ☒ Claim(s) 41-45, 47-49 and 51-54 is/are rejected.
- 7) ☒ Claim(s) 46 and 50 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/6/03</u> | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 45-52 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 45 and 49, it is unclear what terms "said network" as recited in line 27 of claim 45 and line 32 of claim 49 referred to. It is noted that the terms "a network" are previously defined in lines 3 and 9 of claim 45 and lines 4 and 10 of claim 49. According to the drawings of the application, there is one network 7 as shown in figures 1 and 6. From this view, Examiner considers that the terms "network" in lines 3 and 9 of claim 45 and in lines 4 and 10 of claim 49 are the same for examining purpose. Similarly, claim 54 recites the terms "a network" in line 10 and "a network" in line 16. However, there is one network 7 as shown in figures 1 and 6 according to the drawings of the application. From this view, Examiner considers that the terms "network" in line 10 and 16 are the same for examining purpose. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 41-45, 47-49, and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 20050229213 A1) in view of Portuesi (US 5,774,666 A).

Regarding claim 41, Ellis teaches a program-related information providing apparatus (16 – see figures 2a-2e) which includes storage means for storing a program table and program information which serves as attribute information of a program (program guide data), and which sends the program information and the program table (program guide data) to a terminal device (user television equipment or personal computer) via a network (20 or 235 – figures 2a-2e) in response to a request from said terminal device, said program-related information providing apparatus comprising: reception permission means for permitting said terminal device to receive a program in the program table in response to a program viewing request sent from said terminal device (requesting for playback a program); search means for searching for the program information stored in said storage means at the same time said reception permission means permits said terminal device to receive the program (retrieving the program from the storage). (See 0064-0066, 0069-0070 and figures 2a-2e and 14a-14e; 0091; 0094; and 0122-0125).

Ellis further teaches that Internet link may be displayed in an overlay that is displayed on top of the program during playback so that the user may access the Internet link. (See 0074, 0076, 0102, and 0104). Ellis does not explicitly teach generating and transmitting program-related information address displayed script as recited in claim 41. However, Portuesi discloses providing URLs as well as URL descriptions along with a movie file. As a movie playback application 10 plays back the movie file, it reads and interprets URL descriptions from URL tracks. The playback application 10 uses timing and placement information defined for each URL to display the URL to a user at the appropriate time. For example, the playback application 10 displays a hyperlink 32 defined by associated URL track at the appropriate time. Hyperlink is

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displayed and is active within display window 28 only for a specific period of time during playing of image track. See col. 5, lines 20-31 and 40-45; col. 6, lines 2-19 and figure 3. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis by providing an address display time or time information so that an URL address or hyperlink is displayed on the computer terminal at an appropriate time corresponding to the address display time during playing the movie as disclosed by Portuesi in order to appropriately display URL or hyperlink information associated with a program and to allow the user to easily navigate the network resources during playing the program.

Regarding claim 42, Ellis as modified by Portuesi discloses using timing and placement information from the URL descriptions defined for each URL to display the URL to a user at the appropriate time. Hyperlink or URL information is displayed and is active within display window 28 only for a specific period of time during playing of image track. After passing the last image with which URL is associated, hyperlink is no longer displayed in display window (see col. 5, lines 42-45; col. 6, lines 2-9).

Claim 43 recites the similar limitations of claim 41, therefore, claim 43 is rejected for the same reasons as addressed with respect to claim 41 above.

Claim 44 recites the similar limitations of claim 42, therefore, claim 44 is rejected for the same reasons as addressed with respect to claim 42 above.

Regarding claim 45, Ellis teaches a program-related information providing system comprising a program-related information providing apparatus (16 – see figures 2a-2e) and a terminal device (user television equipment or personal computer) connected to each other via a network (20 or 235 – figures 2a-2e), said program-related information providing apparatus including storage means for storing a program table and program information which servers as attribute information of a program (program guide data), and which sends the program

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information and the program table (program guide data) to a terminal device (user television equipment or personal computer) via the network (20 or 235 – figures 2a-2e) in response to a request from said terminal device, said terminal device making a program viewing request of a program in the program table sent from said program-related information providing apparatus (requesting for playback a program), said program-related information providing apparatus comprising: reception permission means for permitting said terminal device to receive the program in the program table in response to the program viewing request sent from said terminal device (requesting for playback a program); search means for searching for the program information stored in said storage means at the same time said reception permission means permits said terminal device to receive the program (retrieving the program from the storage); and said terminal device comprising: first receiving means for receiving the program permitted to be received by said reception permission means of said program-related information providing apparatus; and display means for displaying the program received by said first receiving means. (See 0064-0066, 0069-0070 and figures 2a-2e and 14a-14e; 0091; 0094; and 0122-0125).

Ellis further teaches that Internet link may be displayed in an overlay that is displayed on top of the program during playback so that the user may access the Internet link. (See 0074, 0076, 0102, and 0104). Ellis does not explicitly teach generating/detecting and transmitting/receiving program-related information address displayed script and control means as recited in claim 45. However, Portuesi discloses providing URLs as well as URL descriptions along with a movie file. As a movie playback application 10 plays back the movie file, it reads and interprets URL descriptions from URL tracks. The playback application 10 uses timing and placement information defined for each URL to display the URL to a user at the appropriate time. For example, the playback application 10 displays a hyperlink 32 defined by associated

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URL track at the appropriate time. Hyperlink is displayed and is active within display window 28 only for a specific period of time during playing of image track. See col. 5, lines 20-31 and 40-45; col. 6, lines 2-19 and figure 3. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis by providing an address display time or time information so that an URL address or hyperlink is displayed on the computer terminal at an appropriate time corresponding to the address display time during playing the movie as disclosed by Portuesi in order to appropriately display URL or hyperlink information associated with a program and to allow the user to easily navigate the network resources during playing the program.

Regarding claims 47 and 48, Ellis's system includes distribution system and billing system as shown in figure 1. Portuesi's system provides URL track comprising URL descriptions for displaying the URL or hyperlink to a user at the appropriate time (see col. 5, lines 40-45). Neither Ellis nor Portuesi explicitly teaches charging a fee to an address information provider which provides the address information to the terminal device and/or a higher fee has been paid is preferentially displayed on the terminal device according to the fee charged by the billing means. Official Notice is taken that billing or charging a fee to information provider such as advertiser by broadcaster for broadcasting certain interactive content or advertisement comprising URLs and/or charging a higher fee to advertiser for a larger area of coverage are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis and Portuesi by charging a fee to an information provider, i.e., advertiser, which provides the information, i.e., advertisement, to a terminal device in order to effectively and widely provide information/advertisement to viewers.

Claim 49 recites the similar limitations of claim 45, therefore, claim 49 is rejected for the same reasons as addressed with respect to claim 45 above.

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Claims 51 and 52 recite the similar limitations of claims 47 and 48, therefore, claims 51 and 52 are rejected for the same reasons as addressed with respect to claims 47 and 48 above.

Regarding claim 53, Ellis teaches a program-information providing method for providing program information of a television program (program guide) displayed on a computer terminal (user television equipment or personal computer), comprising: a step of generating the program information (program guide) which includes a broadcast time of the television program and which is used when recording the television program (as shown in figures 14a-14e); a step of preparing program-related information of the television program (Internet link) and a step of generating a URL address of the program-related information on a network (Internet link having URL address is associated with a recorded program); and a step of transmitting the program information and the URL address to said computer terminal. (See 0064-0066, 0069-0070 and figures 2a-2e and 14a-14e; and 0161).

It is noted that in the teaching of Ellis, a user may record programs, program guide data, or a combination thereof in digital form on a storage device of the computer terminal at a time specified by the user. A program may be selected for recording before its scheduled broadcast time and may be recorded before its scheduled broadcast time and may be recorded when the selected program is aired. The recorded program may be played back on the computer terminal in response to a user's request.

Ellis further teaches that Internet link may be displayed in an overlay that is displayed on top of the program during playback so that the user may access the Internet link. (See 0074, 0076, 0102, and 0104). Ellis does not explicitly teach transmitting an address display time so that an URL address is displayed on the computer terminal at a time corresponding to the address display time during playing back the recorded program. However, Portuesi discloses providing URLs as well as URL descriptions along with a movie file. As a movie playback

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application 10 plays back the movie file, it reads and interprets URL descriptions from URL tracks. The playback application 10 uses timing and placement information defined for each URL to display the URL to a user at the appropriate time. For example, the playback application 10 displays a hyperlink 32 defined by associated URL track at the appropriate time. Hyperlink is displayed and is active within display window 28 only for a specific period of time during playback of image track. See col. 5, lines 20-31 and 40-45; col. 6, lines 2-19 and figure 3.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis by providing an address display time or time information so that an URL address or hyperlink is displayed on the computer terminal at an appropriate time corresponding to the address display time during playing back as disclosed by Portuesi in order to appropriately display URL or hyperlink information associated with the program and to allow the user to easily navigate the network resources during playback.

Claim 54 recites the similar limitations of claim 53, therefore, claim 54 is rejected for the same reasons as addressed with respect to claim 53 above.

Allowable Subject Matter

5. Claims 46 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 1-40 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art, Franco (US 20020046407 A1) teaches a system that is remotely programmed through Internet, i.e., a web page, to record broadcast content such as television programs. Particularly, the system comprises a host system 102 hosts a web site through which a user 110 remotely programs a video recording system 120 to record broadcast video content.

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The system provides a clickable programming page on the web page as a program guide having a list of broadcast programs that are selectable for recording. In one embodiment, the system of Franco comprises a programming web site 104 for providing a search utility that allows the user 110 to search for a particular program. The programming web site 104 can present the user 110 the option of making a scheduling request that the particular program be scheduled for broadcast at some time in the near future. The host system receives the scheduling request from the user and then preferably forwards the scheduling request to a scheduling system. The host system 102 receives programming instructions from the scheduling system and formulates programming data that is then transmits to the video recording system 120 in accordance with the user's request. Portuesi (US 5,774,666 A) teaches providing image track along with URL track comprising URL descriptions for displaying the URL or hyperlink to a user at an appropriate time. Both fail to teach the limitations of second program-reserve-record setting script generation means and transmission means as recited in claim 1 and similarly recited in claims 3, 5, and 7; detection means, second receiving means, signal conversion means, and control means as further recited in claim 9 and similarly recited in claims 13, 17, 21, 25, 29, 33, and 37.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ngoc K. Vu
Primary Examiner
Art Unit 2623

November 20, 2006